

REMARKS

The Office Action dated November 13, 2008, rejected claims 31 and 61 under 35 USC § 112, second paragraph. Claims 1, 23-25, 29, 44-45, 49, and 58-64 were rejected under 35 USC § 102 as anticipated by U.S. Patent No. 7,426,475 to Tangellapally (“Tangellapally”). The remaining claims (30-31 and 50) were rejected under 35 U.S.C. § 103(a) as obvious over the combination of Tangellapally and U.S. Patent No. 7,395,215 to Grushka. Applicants respectfully traverse the rejections under § 112, and by this response swear behind the primary cited reference.

The Office Action rejected claim 31 under 35 USC § 112, second paragraph, as indefinite because it uses “approximately” to characterize a compact disk as “approximately the size of a conventional credit card.” The Office Action uses form paragraph 7.34.03, arguing that “the specification does not provide a standard for ascertaining the requisite degree [size?], and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.”

Applicants respectfully traverse, referring in particular to page 16 of the PCT application upon which this application is based, beginning at line 5:

Preferably, the portable readable storage medium 16 is a compact disk 44, and most preferably, the compact disk 44 will be approximately the size of a conventional credit card, so as to be easily carried in a wallet. The use of a compact disk 44 is preferred because most personal computers sold today include compact disk readers.

This disclosure provides significant guidance for one of ordinary skill in the art to determine the scope of the invention recited in claim 31, i.e., the sizes of compact disk that would meet the limitations of claim 31. Those skilled in the art would appreciate that the 80 mm standard diameter for “MiniCD” optical media is quite nearly the same as the width prescribed in the ID-1 size standard (85.60 mm x 53.98 mm) for credit cards, debit cards, and the like. Cards that are approximately those sizes would be “easily carried in a wallet,” and would meet the limitations of claim 31.

Claim 61 was rejected for a lack of antecedent basis for the limitation “the record access certificate” in line 2. As considered in this Office Action, claim 61 depended from claim 58, which recites “saving, on a portable storage medium, a record access certificate for granting remote access ...” (emphasis added). That phrase in parent claim 58 provides antecedent basis for “the record access certificate” in claim 61. With the present amendment, claim 61 now depends from claim 60, which depends from claim 59, which depends from claim 58, so that

antecedent basis remains. Applicants respectfully request that the rejection of claim 61 be reconsidered.

The Office Action rejected claims 1, 23-25, 29, 44-45, 49, and 58-64 as anticipated under 35 USC § 102(b) by U.S. Patent No, 7,426,475 to Tangellapally et al. Applicants observe that the Tangellapally patent issued on September 16, 2008, thereby becoming public years after the priority date of the present application, and had not been published before. Tangellapally is ineligible, therefore, as prior art to the present application under § 102(b). Applicants request, therefore, that the rejection under § 102(b) be withdrawn.

In anticipation of a substitute rejection over the same reference under § 102(e), Applicants remove the Tangellapally reference by presenting evidence of Applicants' invention of the claimed subject matter prior to the filing date of the US provisional application to which that reference claims priority¹. As shown by the attached Declaration of Alan Haaksma Under 37 CFR § 1.131, the inventors conceived of the claimed invention prior to the filing date of the provisional application to which the Tangellapally reference claims priority, then diligently reduced it to practice. This fact excludes the Tangellapally reference from the body of prior art that is available under 35 USC § 102(e). Any rejection under § 102(e) over the Tangellapally reference has been overcome.

Applicants believe that the application is in condition for allowance, and prompt action by the Office toward that end is respectfully requested. In the event any issue(s) remain, the undersigned invites the Examiner to contact him by telephone to expedite the examination of this application. Thank you.

Respectfully submitted,

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¹ Counsel believes that the USPTO misinterprets 35 USC § 102(e) by treating references as if they had been filed on the filing date of provisional applications to which they claim priority, contrary to the plain language of that subsection, by poor parsing of § 120. Understanding that this is the position of the BPAI, counsel does not expect the Examiner to hold otherwise. Applicant reserves this argument for appeal, if necessary.